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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,537	04/25/2001	Takuo Komai	29973-68355	7250

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BARNES & THORNBURG
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Indianapolis, IN 46204

EXAMINER

SANDERS, ALLYSON N

ART UNIT PAPER NUMBER

2876

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/842,537

Applicant(s)

KOMAI, TAKUO

Examiner

Allyson N Sanders

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on January 29, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the Amendment filed January 29, 2003.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 8, 9, 11, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Wellner (5,640,193).

Wellner teaches the following in regards to claims 1-6, 8, 9, 11, 13, and 14:

“The invention provides an apparatus and method for enabling a user to control the selection of electronic services to be provided to the user by one or more servers over a communication medium. The apparatus includes a scanner means for reading marks on an object and for communicating a request signal, having an object code representing the read marks, to a user interface. The interface receives the request signal and transmits to the servers a request command including an interface identification code and the object code to select the desired electronic service.” (Col. 1, lines 33-42).

“According to other aspects of the invention, the scanner means may communicate to the interface means over an infra-red link, a radio link, or over a wired connection. The scanner means may read marks such as bar codes, alphanumeric

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characters or Xerox glyphs. The interface means may be adapted to receive and transmit over a wire pair, cable, optical or radio communication medium.” (Col. 1, lines 47-53).

“As shown in FIG. 1, the system illustratively consists of one or more hand-held scanners or pens (11) that read marks (e.g., bar codes, alphanumeric characters, or Xerox glyphs) on the surface of an object. The object may be paper, plastic or other material. The object may also be mounted onto or be an integral part of an item as a means to identify that item.” (Col. 2, lines 22-27).

“The scanner 11 communicates to the user interface unit 15 (e.g., a set-top box) through a cable, a wire pair (e.g., see scanner pen 11 and wire path 18), an infra-red link, or a radio link 12.” (Col. 2, lines 43-46).

“The memory may also store a scanner pen identification (ID) code to, for example, distinguish signals from different scanner pens which communicate with interface 15.” (Cols. 2 and 3, lines 66-1).

“The interface unit 15 includes means to provide audio and visual feedback to the user and means to transmit codes received from the scanner. The interface unit 15 transmits over communication network 14 to the head-end multimedia server 13. An optional telephone 19 which connects to interface unit 15 may be used to establish a connection to server 13.” (Col. 3, lines 24-28).

“The communication network 14 may be provided by a cable TV company or telephone company or both and can use wire pair or coaxial cables, fiber optic cables, or wireless technology. Moreover, the interface unit (also referred to as an interface) 15

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can also interface to, or be integrated with, a telephone set, a cable TV unit at the user location. The interface unit 15 and television 16 may together be implemented in a well-known manner using, for example, a multimedia computer including a controller, memory, transmitter and receiver units, display unit, etc., so as to implement the features described herein.” (Col. 3, lines 34-45).

“The servers 13 and 17 may illustratively be part of one or more interactive television (ITV) networks 18, which may connect to communication network 14.” (Col. 4, lines 7-9).

“Depending on how much data is represented by the marks 10, it may be possible to access any electronic object on the ITV network 18 with a single swipe, or it may be necessary to make two or more swipes, first to identify a service and establish a connection to it, and then to identify a domain within that service, and finally to identify a specific electronic object controlled by that service.” (Col. 4, lines 57-63).

“In step 302a, the pen 11 may optionally store the mark information for later transmission to interface 15.” (Col. 5, lines 38-40).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 7, 10, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wellner (5,640,193) in view of Komai (5,380,993).

Weiner's teachings are discussed above.

Wellner fails to specifically teach the barcode being a micro barcode a thinnest black bar of which being approximately 100 μ m in width.

Komai teaches the following in regards to claims 7, 10, 12, and 15:

"In recent years, there have been developed technologies for printing bar codes on various media with substantially high precision and to read such bar codes. According to progress of the technology, the so-called micro-bar code, which is much smaller than typical available bar codes, is coming into practical use. The most thin black bar constituting the micro-bar code is 100 μ m width and about 1~10 mm in length." (Col. 2, lines 10-17).

In view of Komai's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the specific micro barcode as the barcode used by Wellner. Although Wellner does not teach the specific type of barcode, the reference does teach scanning a barcode on an item. Micro barcodes are well known in the art and therefore Wellner would have been motivated to use that type of barcode in the method for users to control the selection of electronic multimedia services.

Response to Arguments

6. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

The limitation of the data storing means in which identification data for individually specifying the data output device, which was not met by the prior art disclosed in the previous office action (October 23, 2002) is now met by the Wellner reference. Wellner teaches a memory for storing scanner pen identification code in order to distinguish signals from different scanner pens, which communicate with the interface.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Bain et al (5,315,508).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Allyson Sanders* whose telephone number is (703) 305-5779. The examiner can normally be reached between the hours of 7:30AM to 4:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax phone number for this Group is (703) 308-7722, (703) 308-7724, or (703) 308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [***allyson.sanders@uspto.gov***].

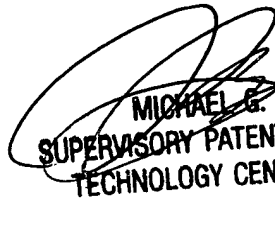
All Internet e-mail communications will be made of record in the application file.
PTO employees do not engage in Internet communications where there exists a

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possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Allyson Sanders
Patent Examiner
Art Unit 2876
June 9, 2003


MICHAEL E. LEE
SUPERVISORY PATENT EXAMINER
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